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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,116	06/20/2002	Tuomo Petaja-Suvanto	3501-1006	8080

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EXAMINER

ROWAN, KURT C

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,116

Applicant(s)

PETAJA-SUVANTO, TUOMO

Examiner

Kurt Rowan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 24-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebert in view of Hunziker.

The patent to Ebert shows a swimming device for testing a fishing lure having two parallel pipe-like means 32, 33. Eberts shows the pipes being connected together by connection means 19, 19 at both ends of the pipes. Eberts shows stilling basins 11, 12 next to the connector means and a control means 41, 42 maintaining the flow for testing the lure 47 lowered into the swimming device. Eberts does not show a lure tower. The patent to Hunziker shows a test tank 10 with a lure tower 34, 35, 36, 50. In reference to claims 24, 34, 41, it would have been obvious to provide the swimming device shown by Ebert with a lure tower as shown by Hunziker for the purpose of preventing water splashing from the top of the pipe. In reference to claims 32 and 40, Eberts discloses a transparent section 23 of testing pipe 32 to view the lure in action. In reference to claims 30, 31 Eberts discloses a control member or propeller 43 in the flow pipe and shows the control means 41, 42 also in the flow pipe 33. In reference to claims 36, 37, Eberts shows a tank 10 with rounded ends that act as connection members which

comprise a stilling basin at the ends, but it would have been obvious to employ two pipes as a hollow tube closed at both ends with first and second connection members since the function is the same and no stated problem was solved. The examiner takes Official Notice that pipes for testing are old and well known. Hunziker shows a vertical alignment with a discharge opening at 45 connecting the lure tower and the testing pipe. In reference to claims 28, 29, 38, Eberts shows concentric control lamellas or protrusions 46, 49 in the basins to prevent swirling downstream of the control member in a direction of fluid flow. In reference to claim 25, Eberts shows the pipes to be the same length but it would have been obvious to change the length of the flow pipe since changes in size are obvious. Hunziker shows a flow pipe 15. In reference to claims 33, 34, 42, Eberts shows the testing pipe having the same diameter and the flow pipe decreasing in diameter along the length, but it would have been obvious to have the testing pipe decrease in diameter for the purpose of changing the flow characteristics noting that changes in size are obvious. In reference to claims 39, 43, both Eberts and Hunziker show the connection members having the same diameter as the flow pipe and the testing pipe, but it would have been obvious to increase the cross sectional area of the connection members since changes in size are obvious. See *In re Rose*, 105 USPQ 137. In reference to claim 26, Hunziker shows the lure tower 34, 35, 36, 50, having a discharge opening that is adjacent to an upstream one of said flow ports in a direction of fluid flow. In reference to claim 27, Eberts shows control lamellas 49, 49, 49 oriented in a longitudinal direction of flow of the pipe for a short distance. Hunziker shows a control lamella 75 oriented in a longitudinal direction of the flow pipe.

Response to Arguments

3. Applicant's arguments filed November 21, 2003 have been fully considered but they are not persuasive. Applicant's response overcomes the rejection under 35 USC 112, second paragraph. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Hunziker shows a vertical alignment and is substantially closed to the outside ambient. Both Ebert and Hunziker show first and second connection members arranged at both ends of flow and testing pipes. Hunziker shows the lure tower extending vertically from the testing pipe. Applicant argues that Eberts could not be modified to a vertical alignment since all the water would run out. However, Hunziker shows a vertical alignment that holds the water. Hunziker also shows a substantially closed system. One skilled in the art would read the basins of both Ebert and Hunziker as being analogous to pipes. As stated above, the examiner takes Official Notice that pipes are old and well known for testing objects in liquids noting the patent to Blair. Clearly Eberts shows a stilling basin noting deflectors 49 which control the water flow and also swirling of the water. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

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teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

4. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is generally available to one of ordinary skill in the art since combining the references would prevent splashing. Whether an apparatus is complicated and or complex to manufacture or assemble is not germane to patentability. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., such as the complexity of the prior art and the scale) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It should be pointed out that it is obvious to scale up or down. In response to applicant's argument that Hunziker is on a larger scale than Eberts or the present invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant's arguments with respect to the other dependent claims have been addressed in the above rejection.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is 703 308-2321. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 703 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kurt Rowan
Primary Examiner
Art Unit 3643

KR